

REMARKS

In the office action mailed September 10, 2007, May 18, 2007, claims 1-9 and 15-17 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. patent no. 5,974,238 to Chase in view of U.S. patent 7,213,039 to Ramanujam, in further view of U.S. pre-grant publication 2002/0029214 by Yianilos.

The claim rejections were improper and must be withdrawn for two reasons.

First, it was improper for the Examiner to have combined *Chase*, *Ramanujam* and *Yianilos* because the references cannot be combined without rendering at least one of them inoperative for its intended purpose or without substantially revising the reference. Second, even if *Chase*, *Ramanujam* and *Yianilos* could be combined, their combination does not disclose each and every pending claim limitation.

In the recent decision of *KSR v. Teleflex*, the U.S. Supreme Court discussed the Federal Circuit's teaching, suggestion, motivation (TSM) obviousness test but the Court essentially held that obviousness under §103 should be determined under the test set that the Court out in *Graham v. Deere*. Obviousness under *Deere* is determined by a consideration of the scope and content of the prior art; differences between the prior art and the claims at issue; and the level of ordinary skill in the pertinent art, however, the plain language of 35 U.C.C. §103 states, and controlling Federal Circuit case law holds that obviousness depends on whether claimed subject matter, "as a whole" would have been obvious at the time of its invention.

In *KSR*, the Court said that "a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art." (Emphasis added.) Other controlling Federal Circuit case law that was not considered or overturned by *KSR* and which still applies, holds that differences between a claimed invention and the prior art, are not to be determined based on whether individual differences themselves would have been obvious but rather whether a claimed invention as a

whole would have been obvious.¹ Obviousness must also be determined by a consideration of the prior art as a whole. Stated another way, it is improper for an Examiner to pick and choose snippets of different references in order to reject a claim under §103.

In addition to considering pending claims as a whole and prior art references as a whole, Federal Circuit case law still holds that when obviousness is based on a combination of references, there must be “reasonable expectation” of the combined references’ success in achieving the claimed result and that the combined references must also disclose each and every pending claim limitation² Other Federal Circuit cases hold that combined references cannot render a pending claim obvious if a proposed modification to a reference that is made in order to combine references would render a prior art reference unsatisfactory for its intended purpose³ nor can combined references render claims obvious if a proposed modification to a combined reference would change a principle of operation of the prior art reference being modified.⁴

With the foregoing in mind, it was clearly improper for the Examiner to have rejected the claims on the combined teachings of *Chase*, *Ramanujam* and *Yianilos*, for at least two reasons.

Chase is the primary reference on which the rejections were based. *Chase* teaches a method by which identical copies of a database that are common to both a desktop computer and a hand-held computer can be synchronized.⁵ *Ramanujam* teaches a method for synchronizing different databases that have different formats.⁶ When the references are each considered “as a whole,” in order for the methodology of *Ramanujam* to be combined with the methodology of *Chase*, as the Examiner’s rejection necessarily requires, one of the two

¹ 35 U.S.C. §103(a). See also MPEP §2141.02, subsection I, citing *Stratoflex, Inc. v. Aeroquip Corp.* 713 F.2d 1530 (Fed. Cir. 1983).

² See MPEP §2143, citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See also MPEP §2143.02 citing *In re Merck Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

³ See MPEP §2143.01, subsection V, citing *In re Gordon*, 733 F.2d 900 (Fed Cir. 1984).

⁴ See MPEP §2143.01, subsection VI, citing *In re Ratti*, 270 F.2d 810 (Fed. Cir. 1959).

identical databases used in *Chase* would have to be modified in order to give one of the databases a different structure. Some of the information in the mobile copy of the database would therefore have to be discarded or lost.

Yianilos discloses a third method for synchronizing databases, which requires hash values to be computed for portions of two identical databases. Hash value differences, if any, indicate differences between the two databases.

When *Chase* is considered as a whole and when *Ramanjuam* is considered as a whole and when *Yianilos* is considered as a whole, as the statute, the Supreme Court and the Federal Circuit all require, someone of ordinary skill in the art would have to modify *Chase* as *Ramanujam* would require and then add a hash code calculation as *Yianilos* would require in order to synchronize the database in a cell phone to a network database. In other words, there is no absolutely reason why someone of ordinary skill in the art would even consider modifying *Chase* to use the database synchronization method of *Ramanjunam* because one of the databases of *Chase* would need to be modified in order to use the method of *Ramanjunam*. At least some of the information stored in the modify copy would have to be discarded.

Even if the combination of *Chase* and *Ramanjunam* were to yield a database synchronization method that would work, and the Examiner has not shown that it would, the Examiner did not present a single reason as to why someone of ordinary skill in the art would have even considered modifying the combination of *Chase* and *Ramanjunam* by adding the computation of hash values required by *Yianilos*, to use in a small, hand-held, battery-powered communication device, which the pending claims, as a whole, are directed toward doing.

In truth, the Examiner's rejection is based on nothing more than a selective choosing and combining of various limitations from various disparate prior art references, without any consideration of either the references or the claims "as a whole." The Examiner purports to have found various limitations in *Chase*, *Ramanjunam* and *Yianilos*, that were ostensibly

⁵ See col. 3, lines 23-55, U.S. patent 5,974,238.

⁶ See Abstract, U.S. patent 7,213,039.

combined but without any regard as to the reality of whether any of them *could* be combined to yield the result achieved by the pending claims or *would* be combined by someone of ordinary skill. The rejections were based solely on the fact that various pending claim limitations were independently, known in the prior art and that since each limitation was ostensibly known, the combination of them rendered the claims to be obvious. In KSR, the U.S. Supreme Court specifically said that such a rejection is improper.

Second, even if the combination of *Chase*, *Ramanjunam* and *Yianilos* was proper, their combination does not satisfy each and every claim element, as other controlling Federal Circuit case law also requires.

Taking pending claim 1 as an example, that claim recites that the “synchronization request” sent from the network to the mobile node, includes within it, “a record” that is to be updated in the mobile device. In other words, a request is sent to the mobile node that both identifies a record to be updated in the mobile node and which includes the new information to be copied into the identified record. None of the references cited by the Examiner disclose the transmission of a synchronization request that both identifies a record to be updated in the mobile node and which also provides the new data to be copied into the identified record. If the Examiner contends otherwise, the applicant asks the Examiner to identify the reference that makes such a disclosure and to identify by column and line number, where the particular reference discloses such a capability.

Notwithstanding the impropriety of the rejection under KSR and other controlling case law, the claims have been amended to further distinguish the pending claims from *Chase*, *Ramanjunam* and *Yianilos*. Paraphrased, each of the independent claims have been amended to expressly state that the synchronization request sent to a mobile node includes the contents of a record to be updated in the mobile node. In other words, a synchronization request identifies a particular record to be updated by an *integer* that is part of the request, however, the request also includes the information that is to be copied into the mobile node record that is to be updated. The claimed method thus saves time, battery power and channel usage over what the cited prior references teach.

Support for the amendments can be found in at least paragraph [0028]. No new matter has been added.

As set forth above, unless the Examiner can justify the combination of *Chase*, *Ramanjunam* and *Yianilos*, the mere fact that various limitations can be found somewhere in the prior art is not enough for the Examiner to conclude that the pending claims are obvious. More importantly, unless the Examiner can identify by column and line number, where each and every claim limitation can be found in *Chase*, *Ramanjunam* and *Yianilos*, the claim rejections must be withdrawn.

The applicant contends that the rejections have been traversed and that the claims are in condition for allowance. Reconsideration of the pending claims is therefore respectfully requested.

Respectfully submitted,

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